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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,690	10/20/2000	Kia Silverbrook	NPA064US	8647

24011 7590 06/30/2004

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

PORTER, RACHEL L

ART UNIT PAPER NUMBER

3626

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,690

Applicant(s)

SILVERBROOK ET AL.

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 10/20/00. Claims 1-44 are pending. The IDS filed 3/19/01 has been entered and considered.

Specification

2. The disclosure is objected to because of the following informalities: references to co-pending and/or earlier US applications should include the serial number of the application(s).

Appropriate correction is required.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Methods and systems for generating printed documents describing insurance services.

Oath/Declaration

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The claimed priority date for Australian application PQ3632 is 10/25/2000 in the declaration. This date conflicts with the priority date on the submitted foreign

document (10/25/1999) and is also after the filing date for the present US application.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1, 4, and 5, it is unclear to the Examiner how the recited "surface" and the recited "form" are distinct from one another. The Examiner understands the term "form" to include information printed on some medium in a particular format. It is unclear whether the recited "form" refers only to an electronic version of information or if the "form" may also include information already embodied on a physical medium (i.e. surface). (The current claim language suggests that the term "form" is used to refer to both electronic and printed versions of the recited information.)

Claims 2-3, and 6-26 inherit the deficiencies of their respective independent claims, and are therefore also rejected.

Claim 27 recites the limitation "a form printed on the surface" in line 27 of page 30. There is insufficient antecedent basis for this limitation in the claim, and it is also unclear which "surface" is being referenced in this line.

Claim 27 further recites "a printer operable to...". The current claim language is vague and indefinite because it does not provide a positive recitation of the printer's functions. In other words, it is unclear whether the recited printer actually performs the step(s) recited in the claim. A similar analysis may be applied to claims 30 and 31, which recite similar language.

Claims 28-29 and 32-44 inherit the deficiencies of their respective independent claims, and are therefore also rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al (USPN 6,076,734) in view of Luchs (USPN 4,831,526).

As per claims 1-26, Dougherty teaches a method for using a computer system including a sensing device to gather information to determine formatting information (e.g. type of form) and positioning data (i.e. reference point) on a physical medium. (col. 5, lines 22-54; col. 6, lines 11-29; Figure 2). Dougherty further discloses that the computer system identifies parameters relating to the task/application performed (i.e. type of document being generated) (col. 7, lines 57-col. 8, line 10) and provides markings or indicia on the surface of interest to distinguish that surface from other

physical media. (col. 5, lines 22-46). Dougherty does not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a method wherein forms relating to insurance services are generated. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses a method in which customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Dougherty with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services. One would have been motivated to include these features to provide an automated system which properly positions information on regarding various insurance services into the appropriate forms, thereby minimizing the need for repetitive entry of insurance data for each insurance application (See Luchs: col. 2, lines 6-18) and producing documents that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

As per claims 27-44, Dougherty teaches a computer system including a sensing device to gather information to determine formatting information (e.g. type of form) and positioning data (i.e. reference point) on a physical medium. (col. 5, lines 22-54; col. 6, lines 11-29; Figure 2). Dougherty further discloses that the computer system identifies parameters relating to the task/application performed (i.e. type of document being

generated) (col. 7, lines 57-col. 8, line 10) and provides markings or indicia on the surface of interest to distinguish that surface from other physical media. (col. 5, lines 22-46). Dougherty does not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a system further comprising a printer and forms, wherein the forms relate to insurance services. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses that customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system Dougherty with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services. One would have been motivated to include these features to provide an automated system which properly positions information on regarding various insurance services into the appropriate forms, thereby minimizing the need for repetitive entry of insurance data for each insurance application (See Luchs: col. 2, lines 6-18) and producing documents that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- DiRienzo et al (USPN 6,076,066) teaches a system and method for automated processing of insurance forms.
- Smutek et al (USPN 4,553,206) teaches a system and method for organizing stored, blocked data for insertion into insurance forms.
- Miller et al (USPN 5,446,653) teaches a system and method for automated generation of insurance documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Alexander L. Birkbeck
ALEXANDER L. BIRKBECK
Art 3626
Primary Examiner